

REMARKS/ ARGUMENTS

The non-final Office Action of October 28, 2008, has been reviewed and these remarks are responsive thereto. By this amendment, claims 39 and 40 have been added, no claims have been canceled and no claims have been amended. No new matter has been added. Claims 1-4, 10-13, 19-22, and 25-40 are pending in this application upon entry of the present amendment. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 1-4, 10-13, 19-22 and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Appl. Pub. No. 2001/0005905 (now U.S. Patent No. 6,505,346) (Saib), in view of U.S. Patent No. 7,324,168 (Griesau). Claims 28, 33, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saib, in view of U.S. Patent No. 7,181,027 (Shaffer). Claims 29, 30, 34, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saib, in view of Shaffer, and further in view of Griesau. Claims 31 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saib, in view of Shaffer, and further in view of U.S. Patent No. 5,844,620 (Coleman). Claims 32 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saib, in view of Shaffer, and further in view of U.S. Patent No. 6,757,906 (Look).

Applicants respectfully traverse these rejections.

Disqualifying Griesau

Claims 1-4, 10-13, 19-22 and 25-27 stand rejected over Saib in combination with Griesau, and claims 29, 30, 34, and 35 stand rejected over Saib in combination with Shaffer and Griesau. However, as discussed, in the Response and Request for Reconsideration dated June 18, 2008, Applicants submit that Griesau is not prior art to the present application, and that the rejections based on Griesau cannot stand.

The Griesau reference has a filing date of October 30, 2002, which is later than the priority date of the present application. Thus, the Griesau reference is not, by itself, available for consideration under 35 USC § 102(c).

Griesau does claim priority to prior non-provisional application serial no. 09/419,605 (the '605 application), filed October 18, 1999, now U.S. Patent No. 6,507,306. However, the Office Action makes no reference to the purported disclosure of the earlier-filed '605 application. The Griesau reference is properly cited against the present application only if "the earlier-filed application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph." (M.P.E.P. 2136.03 (IV)). Specifically, only the portions of Griesau that are supported by the parent application in accordance with 35 U.S.C. § 112, first paragraph are entitled to gain the benefit of the October 18, 1999 priority date. Applicants respectfully submit that it is incumbent upon the Office to find support for the rejection in the earlier '605 application in order to attempt to enter a rejection under 35 U.S.C. §103(a). Because the Office Action does not rely on the disclosure of the '605 application, nor even refer to this earlier-filed application, the rejection is improper.

Applicants further submit that the earlier-filed '605 application does not support a rejection under 35 U.S.C. §103(a). The Office Action alleges on page 3 that Griesau teaches a button in a universal remote control that can be programmed for more than one function at col. 2, lines 16-19 and 54-58, and at col. 2, line 66 to col. 3, line 3. However, none of the relied-upon portions of Griesau are present in the '605 application, nor does any other portion of the '605 application teach or suggest a button that can be programmed for more than one function.

Accordingly, the portions relied upon in Griesau are unavailable as prior art in the rejection of claims 1-4, 10-13, 19-22 and 25-27 under 35 U.S.C. §103(a). Applicants respectfully request that these rejections be reconsidered and withdrawn.

Applicants reserve the right to respond to any assertions of alleged teachings of the above-cited references, as well as the various combinations of these references. Applicants do not do so at this time because Applicants believe that prosecution is most expeditiously advanced by the above arguments.

Claims 28, 31-33, and 36-38

Claims 28, 33, and 38 each recite, "evaluating a depression duration of the button and classifying the depression duration into one of three or more ranges, wherein a first depression duration range is associated with a first function on the multimedia presentation device

controller, a second depression duration range is associated with a second function on the multimedia presentation device controller, and a third depression duration range is associated with a third function on the multimedia presentation device controller." (Emphasis added) The Office Action acknowledges on page 4 that the jump key described in Saib only includes two depression duration ranges. However, the Office Action then alleges that Shaffer cures these deficiencies by disclosing a third duration range at FIG. 4 and col. 8, lines 59-64. Applicants respectfully disagree.

First, the alleged duration ranges of Shaffer are not "depression duration" ranges as recited in claims 28, 33, and 38. Rather, Shaffer's duration ranges relate to the amount of time that audio input is being detected at a microphone. (FIG. 4, col. 9, line 51 – col. 10, line 46) Secondly, none of the alleged functions performed by Shaffer is a "function on [a] multimedia presentation device controller," as recited by claims 28, 33, and 38. In fact, Shaffer does not disclose or relate to multimedia device controllers at all, but describes a noise suppression technique for use in communication systems. (Abstract) Furthermore, it is not clear that there is even an alleged "third function" performed by Shaffer at all. Upon reviewing FIG. 4, it appears that regardless of the duration of the speech input at the microphone, a timer is initialized, a beginning notification is sent, and an ending notification is sent. Although multiple durations are described in relation to system performance, Shaffer does not disclose an alleged "third function" that is performed based on a third duration range.

For at least these reasons, Applicants submit that Shaffer does not teach or suggest "classifying the depression duration into one of three or more ranges, wherein a first depression duration range is associated with a first function on the multimedia presentation device controller, a second depression duration range is associated with a second function on the multimedia presentation device controller, and a third depression duration range is associated with a third function on the multimedia presentation device controller," as recited in claims 28, 33, and 38. Claims 29-32 and 34-37 depending respectively from claims 28 and 33 are not obvious in view of the cited references for at least the same reasons as well as based on the additional patentable features recited therein.

New Claims

Applicants have added new dependent claims 39 and 40 to more fully claim the invention. Support for new claims 39 and 40 can be found, for example, in FIG. 6 of the application as originally filed. No new matter has been added. Claims 39 and 40 are allowable over the cited art for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

CONCLUSION

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated this 28th day of January, 2009

By: /Brian J. Brisnehan/
Brian J. Brisnehan, Registration No. 60,462
1100 13th St., N.W.
Washington, D.C. 20005-4051
Tel: (202) 824-3000
Fax: (202) 824-3001